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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,385	02/17/2004	Hwee Tatz Thai	AD6890 US NA	1626

23906 7590 10/31/2006

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EXAMINER	
RONESI, VICKEY M	
ART UNIT	**PAPER NUMBER**
1714	

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

C

Office Action Summary	Application No.	Applicant(s)	
	10/780,385	THAI ET AL.	
	Examiner	Art Unit	
	Vickey Ronesi	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *8/23/04, 4/13/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The Information Disclosure Statements dated 8/23/2004 and 4/13/2005 have been considered, however, it is noted that the PCT International Search reports on the IDS dated 4/13/2005 have been struck from the IDS because they are not publications with a date.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-8, 11, and 31-36 are rejected under 35 U.S.C. 102(b) as being anticipated by GB '809 (GB 902,809, cited on IDS dated 4/13/2005).

GB '809 discloses a composition for use in fibers and films (page 1, lines 30; page 3, line 77) comprising polypropylene and 5-50 wt % of ethylene/alkyl acrylate copolymer (page 1, lines 68-73) such as exemplified ethylene/methyl acrylate and ethylene/butyl acrylate (table on page 6), wherein the composition is cooled in a water bath (page 3, lines 48-49).

In light of the above, it is clear that GB '809 anticipates the presently cited claims.

Claim Rejections - 35 USC § 102/103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 11-14 and 39 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over GB '809 (GB 902,809, cited on IDS dated 4/13/2005).

The discussion with respect to GB '809 in paragraph 2 above is incorporated here by reference.

Claims 11-14 and 39 are product-by-process claims and therefore "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

In light of the above, GB '809 anticipates the presently cited claims.

Alternatively, in the event any differences can be shown for the product of the product-by-process claims, as opposed to the product taught by GB '809, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

Claim Rejections - 35 USC § 103

4. Claims 9, 10, 37, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB '809 (GB 902,809, cited on IDS dated 4/13/2005).

The discussion with respect to GB '809 in paragraph 2 above is incorporated here by reference.

GB '809 discloses additives such as colorants, stabilizers, and UV densensitizers (page 3, lines 78-82), however, it does not explicitly disclose the amounts of such additives. Nevertheless, GB '809 teaches that the selection and incorporation of such additives can be conducted in accordance with principles and procedures within the knowledge and skill of the art (page 3, lines 84-87). It is therefore the examiner's position that the amounts of the additives are result effective variables because changing them will clearly affect the type of product obtained as taught by GB '809. See MPEP § 2144.05 (B). Case law holds that "discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art." See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

In view of this, it would have been obvious to one of ordinary skill in the art to utilize suitable amounts of additives, including those within the scope of the present claims, so as to produce desired end results.

5. Claims 15-30 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB '809 (GB 902,809) in view of JP '785 (abstract of JP 52-142785, cited on IDS dated 4/13/2005) and Peacock (US 5,272,003).

A full English-language translation of JP 52-142785 has been ordered.

The discussion with respect to GB '809 in paragraphs 2 and 4 above is incorporated here by reference.

While GB '809 discloses the use of its composition in film and fibers, it does not teach a method including steps of cooling by quenching by water bath, chill roll, or tubular blow film and slitting a film of the composition into tapes and hot-drawing and annealing the tape. GB '809 also does not disclose non-woven fabrics.

JP '785 discloses a composition comprising polypropylene and an ethylene/ethyl acrylate copolymer and teaches that the composition is suitable for forming into a film, cutting the film into tapes, and then elongating the tapes to form fibers (abstract). Peacock further elaborates on this process with syndiotactic polypropylene resin and teaches that this process includes quenching a film by water bath or chill roll or air-cooled by blowing the film, wherein the slit tapes are then drawn and annealed to control heat shrinkage (col. 6, lines 23-54). Fibers formed from this process are suitable for nonwoven fabrics (col. 6, line 56).

Given that GB '809 discloses that its composition is useful in films and tapes and further given that a composition like the one disclosed by GB '809 is suitable for a process of slitting film to form fibers as taught by JP '785, it would have been obvious to one of ordinary skill in the art to quench the film and hot-draw and anneal the slit film tapes as taught by Peacock to form fibers which can be nonwoven fabrics.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v.*

Eagle Mfg. Co., 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 1-40 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-15 and 23-46 of copending Application No. 10/865,265 (published as US PGPub 2004/0224591. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claims 1-15 and 23-46 of US appl. '265 are identical to instant claims 1-40.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-10, 13, 17-24, and 31-40 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 6-8, 10,

14, 17, and 18 of copending Application No. 11/072,383 (published as US PGPub 2005/0203232). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

US appl. '383 claims an oriented film and fiber comprising a polypropylene, 0.1-30 wt % of at least E/X/Y copolymer wherein X can be an alkyl (meth)acrylic esters and Y can be an optional comonomer, and 0.1-40 wt % additives. Given that the presently claimed ethylene/acrylate copolymer is immediately envisaged from the claimed formula in US appl. '383, it would have been obvious to one of ordinary skill in the art to obtain a film comprising a polypropylene and ethylene/alkyl acrylate copolymer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The International Search Reports for PCT/US04/019658 and PCT/US04/006465 cited as X references US 5,614,574, WO 95/33882, WO 02/12390, and EP 1 283 243. They are cumulative to the prior art rejections of record.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10/25/2006
Vickey Ronesi

CALLIE E. SHOSHO
PRIMARY EXAMINER